

II. REMARKS

A. Introduction

The Final Office Action dated January 13, 1998 (Final Office Action) has been carefully reviewed and the following arguments are made in response thereto.

Claims 2-7 are pending in the application.

Claims 2-7 stand rejected under 35 U.S.C. § 102 (b) as allegedly being anticipated by Campbell, et al., U.S. Patent No. 4,536,791 ("Campbell").

Claims 2-7 remain active in this application. No new matter is presented.

B. Response to Requirement Imposed Upon Applicants to Resolve Alleged Conflicts Between Applicants' Applications.

Applicants respectfully traverse the requirements of the Final Office Action paragraph 5.

Paragraph 5 of the Final Office Action requires Applicants to either:

- (1) file terminal disclaimers in each of the related 329 applications terminally disclaiming each of the other 32[8] applications; or
- (2) provide an affidavit attesting to the fact that all claims in the 328 applications have been reviewed by applicant and that no conflicting claims exist between the applications; or
- (3) resolve all conflicts between claims in the related 329 applications by identifying how all the claims in the instant application are distinct and separate inventions from all the claims in the above identified 329 applications.

In addition, Examiner states that failure to comply with any one of these requirements will result in abandonment of the application.

Examiner states that the requirement has been made because conflicts exist between claims of the related co-pending applications, including the present

application. Examiner sets forth only the serial numbers of the co-pending applications without an indication of which claims are conflicting. Examiner has also attached an Appendix providing what is deemed to be clear evidence that conflicting claims exist between the 329 related co-pending applications and the present application. Further, Examiner states that an analysis of all claims in the 329 related co-pending applications would be an extreme burden on the Office requiring millions of claim comparisons.

Applicants respectfully traverse these requirements in that Examiner has both improperly imposed the requirements, and has incorrectly indicated that abandonment will occur upon failure to comply with the requirement. Applicants' traversal is supported by the fact that 37 C.F.R. § 1.78 (b) does not, under the present circumstances, provide Examiner with authority to require Applicants to either: 1) file terminal disclaimers; 2) file an affidavit; or 3) resolve all apparent conflicts. Additionally, the penalty of abandonment of the instant application for failure to comply with the aforementioned requirement is improper for being outside the legitimate authority to impose abandonment upon an application. The following remarks in Section (B) will explain Applicants' basis for this traversal.

**1. The PTO's New Requirement is an Unlawfully
Promulgated Substantive Rule Outside the
Commissioner's Statutory Grant of Power**

The PTO Commissioner obtains his statutory rulemaking authority from the Congress through the provisions of Title 35 of the United States Code. The broadest grant of rulemaking authority -- 35 U.S.C. § 6 (a) -- permits the Commissioner to promulgate regulations directed only to "the conduct of proceedings in the [PTO]". This provision does NOT grant the Commissioner authority to issue substantive rules of patent law. Animal Legal Defense Fund v. Quigg, 932 F.2d 920, 930, 18 U.S.P.Q.2d

1677, 1686 (Fed Cir. 1991).¹ Applicants respectfully submit that the Examiner's creation of a new set of requirements based upon 37 CFR § 1.78(b) constitutes an unlawful promulgation of a substantive rule in direct contradiction of a long-established statutory and regulatory scheme.

2. The PTO's Requirement is a Substantive Rule

The first determination is whether the requirement as imposed by the PTO upon Applicants is substantive or a procedural rule. The Administrative Procedure Act offers general guidelines under which all administrative agencies must operate. A fundamental premise of administrative law is that administrative agencies must act solely within their statutory grant of power. *Chevron v. Natural Resources Defense Council*, 467 U.S. 837 (1984). The PTO Commissioner has NOT been granted power to promulgate substantive rules of patent law. *Merck & Co., Inc. v. Kessler*, 80 F.3d 1543 (Fed. Cir. 1996), citing, *Animal Legal Defense Fund v. Quigg*, 932 F.2d 920, 930, 18 U.S.P.Q.2d 1677, 1686 (Fed. Cir. 1991).

The appropriate test for such a determination is an assessment of the rule's impact on the Applicant's rights and interests under the patent laws. *Fressola v. Manbeck*, 36 U.S.P.Q.2d 1211, 1215 (D.D.C. 1995). As the PTO Commissioner has no power to promulgate substantive rules, the Commissioner receives no deference in his interpretation of the statutes and laws that give rise to the instant requirement. *Merck & Co., Inc. v. Kessler*, 80 F.3d 1543 (Fed Cir. 1996), citing, *Chevron v. Natural Resources Defense Council*, 467 U.S. 837 (1984). When agency rules either (a) depart from existing practice or (b) impact the substantive rights and interests of the effected party, the rule

¹Accord *Hoechst Aktiengesellschaft v. Quigg*, 917 F.2d 522, 526, 16 U.S.P.Q.2d 1549, 1552 (Fed Cir. 1990); *Glaxo Operations UK Ltd. v. Quigg*, 894 F.2d 392, 398-99, 13 U.S.P.Q.2d 1628, 1632-33 (Fed. Cir. 1990); *Ethicon Inc. v. Quigg*, 849 F.2d 1422, 1425, 7 U.S.P.Q.2d 1152, 1154 (Fed. Cir 1988).

must be considered substantive. *Nat'l Ass'n of Home Health Agencies v. Scheiker*, 690 F.2d 932, 949 (D.C. Cir. 1982), *cert. denied*, 459 U.S. 1205 (1983).

a. **The PTO Requirement is Substantive Because
it Radically Changes Long Existing Patent
Practice by Creating a New Requirement
Upon Applicants Outside the Scope of 37
C.F.R. § 1.78 (b)**

The Examiner's requirement is totally distinguishable from the well articulated requirement authorized by 37 CFR § 1.78 (b), because it (1) creates and imposes a new requirement to avoid abandonment of the application based on the allegation that conflicts exist between claims of the related 329 co-pending applications, and (2) it results in an effective final double patenting rejection without the PTO's affirmative double patenting rejection of the claims. Long existing patent practice recognizes only two types of double patenting, double patenting based on 35 U.S.C. § 101 (statutory double patenting) and double patenting analogous to 35 U.S.C. § 103 (the well-known obviousness type double patenting).² These two well established types of double patenting use an objective standard to determine when they are appropriate³ and have a determinable result on the allowability of the pending claims.

²MPEP § 804(B)(1) states, in an admittedly awkward fashion, that the inquiry for obviousness type double patenting is analogous to a rejection under 35 U.S.C. 103: "since the analysis employed in an obvious-type double patenting determination parallels the guidelines for a 35 U.S.C. 103 rejection, the factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 U.S.P.Q. 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103 are employed when making an obvious-type double patenting analysis".

³ The objective test for same invention double patenting is whether one of the claims being compared could be literally infringed without literally infringing the other. The objective test for obviousness type double patenting is the same as the objective nonobviousness requirement of patentability with the difference that the disclosure of the first patent may not be used as prior art.

The Examiner's new requirement represents a radical departure from long existing patent practice relevant to conflicting claims between co-pending applications of the same inventive entity. Two well established double patenting standards are based on an objective analysis of comparing pending and *allowed* claims. However, in the present application, there are no *allowed* claims. The Examiner's new requirement to avoid a double patenting rejection presumes that conflicts exist between claims in the present application and claims in the 328 co-pending applications. This presumption of conflicts between claims represents a radical departure from long existing patent practice as defined by 37 C.F.R. § 1.78 (b), which states:

Where two or more applications filed by the same applicant contain conflicting claims, elimination of such claims from all but one application may be required in the absence of good and sufficient reason for their retention during pendency in more than one application.

Clearly, the only requirement authorized by the rule is the elimination of conflicting claims from all but one application where claims have been determined to exist. Furthermore, in order to determine that conflicting claims do in fact exist in multiple applications, the only possible analysis is obviousness-type double patenting, since there are no allowed or issued claims by which to employ the 35 U.S.C. § 101 statutory double patenting analysis. Once obviousness-type double patenting analysis has been applied and conflicting claims have been determined to exist, only a *provisional* obviousness-type double patenting rejection is possible until claims from one application are allowed.

In summary, the Examiner's new requirement departs from long-established practice because it (1) creates and imposes a new requirement to avoid abandonment of the application based on the allegation that conflicts exist between claims of the related 328 co-pending applications, and (2) it results in an effective final double patenting rejection without the PTO's affirmative double patenting rejection of the claims.

Therefore, the Examiner's new requirement departs from existing practice and therefore is a **substantive rule** beyond the authority of the PTO and is therefore, invalid.

b. **The New Requirement is Also a Substantive Rule Because it Adversely Impacts the Rights and Interests of Applicants to Benefits of the Patent**

The rights and benefits of a U.S. patent is solely a statutory right. *Merck & Co., Inc. v. Kessler*, 80 F.3d 1543 (Fed Cir. 1996). The essential statutory right in a patent is the right to exclude others from making, using and selling the claimed invention during the term of the patent. Courts have recognized that sometimes new procedural rules of the PTO are actually substantive rules, e.g. when the new rule made a substantive difference in the ability of the applicant to claim his discovery. *Freesola v. Manbeck*, 36 U.S.P.Q.2d 1211, 1214 (D.D.C. 1995) (emphasis added), citing, *In re Pilkington*, 411 F.2d 1345, 1349; 162 U.S.P.Q. 145 (C.C.P.A. 1969); and *In re Steppan*, 394 F.2d 1013, 1019; 156 U.S.P.Q. 143 (C.C.P.A. 1967).

The new requirement, on its face and as applied here, is an instance of a PTO rule making a substantive difference in Applicants ability to claim their invention and, therefore, must be considered a substantive rule. The requirement denies Applicants rights and benefits expressly conferred by the patent statute. The measure of the value of these denied rights and benefits is that the requirement, as applied here, would deny Applicants the full and complete PTO examination of Applicants' claims on their merits, as specified by 37 C.F.R. § 1.105. In addition, to file terminal disclaimers in each of the related 329 applications terminally disclaiming each of the other 328 applications based on the PTO's incomplete examination on the merits would deny Applicants the benefit of the full patent term of 17 years on each of Applicants respective applications.

Applicants respectfully submit that the requirement has a huge impact on their rights and interests in the presently claimed invention.

c. Conclusion: Substantive Rule

In summary, the requirement is a change to a long existing practice and/or has a substantive impact on the rights and interests of Applicants to their invention. Either finding means that the new requirement is a substantive rule. Because the Commissioner has no power to issue substantive rules, the requirement is an improperly promulgated substantive rule having no force of law.

3. The PTO Requirement is Outside the Scope of 37 C.F.R. § 1.78 (b)

Rule 78 (b) states that:

Where two or more applications filed by the same applicant contain conflicting claims, elimination of such claims from all but one application may be required in the absence of good and sufficient reason for their retention during pendency in more than one application.

The only **requirement** that Rule 78 (b) authorizes is the elimination of conflicting claims from all but one co-pending applications.

In the instant Final Office Action, Examiner has not required the elimination of all conflicting claims from all but one application, but instead has required Applicants to: 1) file terminal disclaimers in each of the related 329 applications; 2) provide an affidavit; or 3) resolve all conflicts between claims in the related 329 applications. None of the options in the requirement is authorize by Rule 78 (b), and therefore Applicants respectfully submit that such a requirement is improper.

With respect to the PTO's authority to act within Rule 78 (b) regarding the rejection of conflicting claims, M.P.E.P § 822.01 states that:

Under 37 CFR § 1.78 (b), the practice relative to overlapping claims in applications copending before the examiner..., is as follows: Where claims in one application are unpatentable over claims of another application of

the same inventive entity because they recite the same invention, *a complete examination should be made of the claims of each application* and all appropriate rejections should be entered in each application, including rejections based upon prior art. *The claims of each application may also be rejected on the grounds of provisional double patenting on the claims of the other application* whether or not any claims avoid the prior art. Where appropriate, the same prior art may be relied upon in each of the applications. MPEP 822.01 (6th Ed., Rev. 3, 1997), (*emphasis added*).

In light of the requirement of the Final Office Action, M.P.E.P § 822.01 and 37 CFR § 1.78 (b) are not applicable since there has not been any rejection with regard to the elimination of conflicting claims from all but one co-pending application.

4. The Assertion That Failure to Comply with the Requirement Will Result in Abandonment of Applicants' Application is Improper

Applicants' prospective failure to comply with the above requirements cannot properly result in abandonment of the present application. Applicants respectfully submit that abandonment of an application can properly occur only:

- (1) for failure to respond within a provided time period (under Rule 135);
- (2) as an express abandonment (under Rule 138); or
- (3) the result of failing to timely pay the issue fee (under Rule 316).

There is no provision in the rules permitting abandonment for failure to comply with any of the presented requirements. To impose an improper requirement upon Applicants and then hold the application is to be abandoned for failure to comply with the improper requirement violates the rules of practice before the USPTO.

Furthermore, Examiner is in effect attempting to create a substantive rule which is above and beyond the rulemaking authority of the USPTO, and therefore is invalid.

In the *Application of Mott*, 539 F.2d 1291, 190 USPQ 536 (CCPA 1976), the applicant had conflicting claims in multiple applications. The CCPA held that action by Examiner which would result in automatic abandonment of the application was legally untenable. *Id.* at 1296, 190 USPQ at 541. In the present application, Examiner has

asserted that there are conflicting claims in multiple applications, and that non-compliance of the Final Office Action's requirement will result in an automatic abandonment. Therefore, under *Mott's* analysis, the Final Office Action's result of abandonment of Applicant's application is legally untenable.

5. Response to Apparent Conflict of Claims

Applicants submit that the presentation of the Final Office Action Appendix fails to demonstrate any conflicts between claims of the present application and claims of the co-pending applications. Rather, the Final Office Action Appendix compares representative claims of *other* applications in attempt to establish that "conflicting claims exist between the 329 related co-pending applications." Absent any evidence of conflicting claims between the Applicants' present application and any other of Applicants' co-pending applications, any requirement imposed upon Applicants to resolve such alleged conflicts is improper.

6. Request for Withdrawal of Requirement

Therefore, Applicants respectfully request that Examiner reconsider and withdraw the requirement that Applicants: (1) file terminal disclaimers in each of the related 329 applications terminally disclaiming each of the other 328 applications; (2) provide an affidavit attesting to the fact that all claims in the 329 applications have been reviewed by applicant and that no conflicting claims exist between the applications; or (3) resolve all conflicts between claims in the above identified 329 applications by identifying how all the claims in the instant application are distinct and separate inventions from all the claims in the above identified 329 applications, which upon failing to do so will abandon the application.

7. Filing of Supplemental Oath

Notwithstanding the foregoing, Applicants will file a supplemental oath under 37 C.F.R. § 1.67 for each application when Examiner identifies allowable subject matter. Applicants respectfully propose that the filing of individual supplemental oaths attesting to the absence of claim conflicts between previously patented claims and subsequently allowed claims is a more reasonable method of ensuring the patentable distinctness of subsequently allowed claims.

Under 37 C.F.R. § 1.105, § 1.106 & § 1.78 (b), Examiner has the duty to make every applicable rejection, including double patenting rejection. Failure to make every proper rejection denies Applicants all rights and benefits related thereto, e.g., Applicants' right to appeal, etc. Once obviousness-type double patenting analysis has been applied and conflicting claims have been determined to exist, only a *provisional* obviousness-type double patenting rejection is possible until claims from one application are allowed.

C. Information Disclosure Statement

The Applicants appreciate the Examiner's review of the Information Disclosure Statement filed April 7, 1997 and have addressed those specific concerns raised in the office action. It is the Applicants' understanding that the Examiner raised the following 5 issues:

- (1) the reasons for such a large number of references cited,
- (2) foreign language references cited without a statement of relevance or translation have not been considered,
- (3) the relevancy of numerous references listed in the Information Disclosure Statements are subsequent to the Applicants' latest effective filing date of 9/11/87,
- (4) citation of references apparently unrelated to the subject matter of the claimed invention, and

(5) citation of database search results listed in foreign languages where no copy was provided.

1. Reason for Citation of Large Number of References

The reason that the Applicants submitted such a large number of references in the Information Disclosure Statements was that a large portion of the information cited by the Applicants was brought to the Applicants' attention in the discovery processes in a previous litigation in the United States District Court for the Eastern District of Virginia (*Personalized Mass Media Corp. v. The Weather Channel, Inc.* Docket No. 2:95 cv 242) and an investigation by the International Trade Commission (*In the Matter of Certain Digital Satellite System (DSS) Receivers And Components Thereof*, No. 337 TA 392, which was direct to U.S. Pat. No. 5,335,277) regarding claims in the Applicants' related issued patents. The documents listed in the Information Disclosure Statement were cited during the previous litigation/investigative proceedings by the alleged infringers in the aforementioned proceedings as being relevant and material to patentability of the claims in the related patents. The Applicants submitted those materials in the Information Disclosure Statement to the PTO at the earliest possible time in order to file them in compliance with the 3 month requirement stated in the certification used to submit the Information Disclosure Statement before the Final Office Action was issued as is necessary under 37 CFR § 1.97 (c) (1). In such haste, entries were inadvertently submitted which do not appear on their face to be material to the patentability of the present application. Applicants have corrected this error with the submission of the corrected Information Disclosure Statement as shown in Appendix B. However, it is the Applicants' understanding that not all references cited must be material to patentability in order for such references to be considered. In § 609 of the MPEP, it states,

"[t]hese individuals also may want the Office to consider information for a variety of reasons: e.g., without first determining whether the information meets any particular standard of materiality, or because another patent

office considered the information to be relevant in a counterpart or related patent application filed in another country, or to make sure that the examiner has an opportunity to consider the same information that was considered by the individuals that were substantially involved in the preparation or prosecution of a patent application.”

Applicants’ position is that information that was considered material in previous litigation would fall into the ‘variety of reasons’ category as stated above. Applicants intention was not to confuse or make difficult the examination process for the Examiner, but was instead to be forthright and open in disclosing all information deemed to be relevant to the application in issue by third parties.

2. Citations of Foreign Language References

Applicants have re-examined the foreign references listed in all of the Information Disclosure Statements and have either eliminated such references from the list, included translations herewith or provided statements as to the relevancy of such references (APPENDIX A). The inclusion of translations with this response is in compliance with 37 C.F.R. § 1.97 (f) which states in part, “[I]f a bona fide attempt is made to comply with 37 C.F.R. § 1.98, but part of the required content is inadvertently omitted, additional time may be given to enable full compliance.” The omission of any translations and/or relevancy statements for foreign references was inadvertent and unintentional and are herein submitted in accordance with 37 C.F.R. § 1.97 (f).

3. References in the Information Disclosure Statements Subsequent to Applicants’ Latest Effective Filing Date of 9/11/87

Examiner stated “[n]umerous references listed in the IDS are subsequent to the applicant’s latest effective filing date of 9/11/87, therefore, the relevancy of those references is unclear.” Upon further examination, the Applicants have eliminated those patents and publications after the effective filing date for the present application. It is the Applicants’ understanding that the effective for the present application is 9/11/87.

4. Citation of Unrelated References

Applicants appreciate the Examiner pointing out such references that were listed yet on their face appear to be unrelated to the subject matter of the present application. In response to such information, the Applicants have reviewed the cited references and removed any such references which appear to be unrelated on their face to the claimed subject matter such as the patent for a beehive, the patent for a chemical compound and numerous computer printout search results.

5. Citation of Database Search Results

Database search results listed in foreign languages where no copy was provided have been eliminated from the substitute Information Disclosure Statement included with this office action.

The Applicants' offer the corrected Information Disclosure Statement (APPENDIX B) as a substitute to the previously filed Information Disclosure Statement filed 4/7/97. No new entries have been entered, only citations which have, upon further examination, been determined not to be relevant to the claimed subject matter have been eliminated, typographical errors have been corrected, dates inserted where possible and the list shortened as a result. It is the Applicants' intention that such corrected Information Disclosure Statement will help clarify any issues previously raised by the Examiner and aid in the prosecution of the present patent application.

D. Response to Rejection of Claims for Absence of Novelty

1. 35 U.S.C. § 102 (b) Rejection over Campbell

Claims 2-7 stand rejected under 35 U.S.C. § 102 (b) as allegedly being anticipated by Campbell.

With respect to Applicants' claim 2, Campbell et al. fails to teach, *inter alia*, a method "for generating a television display at a receiver station" and a method for "generating and communicating a video image ... in response to ... digital data" as

claimed by Applicants. The Examiner states that the "mere switching of the screen to black is considered generation of a television display." Switching a screen to black is not "generating a television display." As the Examiner states, providing a black screen is merely switching. No generation of a video image is required in switching a screen to black. As indicated in claim 2, a processor generates a video image based on digital data detected in the a television signal. This generation requires more than a simple switching to a black screen.

Campbell uses data signals in video line format which are inserted in the vertical interval of a television signal. Campbell's data signals do not cause the generation and communication of a video image, as does the digital data of Applicants' claimed invention. Campbell's data signals are merely information carrying signals which do not initiate any action regarding the generation and communication of a video image. These signals do not correspond to the clear-and-continue signals as claimed by Applicants. Applicants' clear-and-continue signals control the processor to clear a portion of an output memory, jump to a predetermined instruction and generate video image information based on the predetermined instruction.

Additionally, Campbell does not disclose or suggest clear-and-continue signals that control a processor at a receiver station to clear a portion of an output memory, jump to a predetermined instruction and generate video image information based on the predetermined instruction. The Examiner states that clearing a portion of a memory "can be considered simply generating a black screen." As noted above, the Examiner first states that the mere switching of a screen to black is considered generation of a television display. The Examiner then states that generating a black screen can be considered to be clearing a portion of a memory. It is impermissible for an Examiner to use a single element in a reference to show that two features of a claimed invention. Under 35 U.S.C. Section 102, a claim is invalid as being anticipated if each and every element of a claim is shown, either expressly or under principles of inherency, in a

single prior art disclosure. *Tyler Refrigeration v. Kysor Indus. Corp.*, 777 F.2d 687 (Fed. Cir. 1985). If elements in a claim are separately set forth, the Examiner must use a reference(s) showing the distinct elements.

Furthermore, the Examiner refers to column 22, lines 10-14 of Campbell wherein "the filling of the memory 130 with appropriate data" is deemed to correspond with the step of clearing a portion of an output memory. Applicants are unclear as to how a step of filling the memory with appropriate data may be considered to be the same as clearing a portion of the memory. Clearing a portion of memory entails removing the contents thereof, not inserting additional material. Also, Campbell states that the filled data is formatted which indicates that the memory is not being filled with blank data.

Campbell does not teach or suggest *at least* using clear-and-continue signals, therefore, Campbell cannot be said to anticipate Applicants claimed invention. Campbell does not teach or suggest inputting a clear-and-continue signal to a processor in response to digital data detected in a television signal, controlling the processor based on the clear-and-continue signal, wherein the step of controlling comprises the steps of: (a) clearing at least a portion of an output memory; (b) jumping to a predetermined instruction; and (c) generating video image information based on said predetermined instruction.

Because claims 3-5 depend from claim 2, Applicants believe that claims 3-5 are allowable for at least the foregoing reasons. Therefore, Applicants respectfully request that the 35 U.S.C. § 102 (b) rejection of claims 2-5 be withdrawn.

Applicants' claim 6 discloses a method of generating a television display at at least one of a plurality of receiver stations. A clear-and-continue signal is received which is effective at a receiver station to control the receiver station's processor to clear a portion of an output memory, jump to a predetermined instruction and generate video image information based on the predetermined instruction. A control signal is also received which operates at a transmitter station to communicate the clear-and-

continue signal to a transmitter. As discussed above, Campbell's data signals are merely carry information which do not initiate any action regarding the generation and communication of a video image. These signals do not correspond to the clear-and-continue signals as claimed by Applicants. Applicants' clear-and-continue signals control the processor to clear a portion of an output memory, jump to a predetermined instruction and generate video image information based on the predetermined instruction. These features are neither taught nor suggested by Campbell.

Additionally, the Examiner states that filling memory with appropriate data is considered to be the same as clearing a portion of an output memory. As discussed above, clearing a portion of an output memory is not equivalent to filling memory with appropriate data. Clearing a portion of memory is exactly the opposite of filling memory with appropriate data. Furthermore, Campbell states that the filling data is formatted prior to displaying on a user's television set. This indicates that the memory is not being filled with blank data.

As stated above, Campbell does not teach or suggest *at least* using clear-and-continue signals, therefore, Campbell cannot be said to anticipate Applicants claimed invention. Campbell does not teach or suggest (a) receiving a clear-and-continue signal, (b) receiving a control signal which operates at a transmitter station to communicate the clear-and-continue signal to a transmitter; and (c) transmitting the clear-and-continue signal, the clear-and-continue signal effective at the at least one of a plurality of receiver stations to control the processor to clear at least a portion of an output memory, jump to a predetermined instruction, and generate video image information based on the predetermined instruction.

Applicants' claim 7 discloses a method for generating a television display at at least one of a plurality of receiver stations. A clear-and-continue signal is received and stored, then communicated to a transmitter at a specified time. The clear-and-continue signal controls a processor at a receiver station to clear a portion of output memory,

jump to a predetermined instruction and generate video image information based on the predetermined instruction. Campbell does not teach or suggest clear-and-continue signals that are received, stored and communicated to a transmitter at a specific time. As stated above, Campbell's data signals simply provide information. These signals do not control any aspect of Campbell's system. Applicants' invention, on the other hand, provide clear-and-continue signals that control the processor to perform certain functions. Campbell's data signals do not provide any controlling characteristics.

As discussed above, the Examiner states that the feature described in Campbell (i.e., filling memory with appropriate data, column 22, lines 10-14) is considered to be the same as clearing a portion of an output memory. Clearing a portion of an output memory is the opposite of filling memory with appropriate data. Furthermore, Campbell states that the filling data is formatted prior to displaying on a user's television set. This indicates that the memory is not being filled with blank data.

Campbell does not teach or suggest *at least* using clear-and-continue signals, therefore, Campbell cannot be said to anticipate Applicants claimed invention. Campbell does not teach or suggest receiving and storing a clear-and-continue signal; and causing the clear-and-continue signal to be communicated to a transmitter at a specific time, thereby to transmit the clear-and-continue signal, the clear-and-continue signal effective at the at least one of a plurality of receiver stations to control the processor to clear at least a portion of an output memory, jump to a predetermined instruction, and generate video image information based on the predetermined instruction.

Applicants respectfully submit that the cited art does not anticipate claims 2-7 because the reference fails to disclose every element of the claimed invention, and Applicants respectfully request that the 35 U.S.C. § 102 (b) rejection of claims 2-7 be withdrawn.

Applicants further respectfully submit that claims 2-7 in the present application should be allowed because these methods are not disclosed, taught, suggested, or implied by the applied reference. For a reference to anticipate in terms of 35 U.S.C. § 102, every element of the claimed invention must be identically shown in a single reference. *In re Bond*, 910 F.2d 831, 15 U.S.P.Q.2d 1566 (Fed. Cir. 1990). There must be no difference between the claimed invention and the reference disclosure, as viewed by a person of ordinary skill in the field of the invention. *Scripps Clinic & Research Foundation v. Genetech, Inc.*, 927 F.2d 1565, 18 U.S.P.Q.2d 1001, 18 U.S.P.Q.2d 1896 (Fed. Cir. 1991). Absence from a cited reference of any element of a claim negates anticipation of that claim by the reference. *Kloster Speedsteel AB v Crucible, Inc.*, 230 U.S.P.Q. 81 (Fed. Cir. 1986), *on rehearing*, 231 U.S.P.Q. 160 (Fed. Cir. 1986).

2. 35 U.S.C. § 102 (a), § 102 (e)

The Office Action provides a quotation for all § 102 rejections set forth in the instant Office Action. Office Action, ¶ 7. Quotations from § 102 (a) and § 102 (e) are included. The Office Action, however, does not reject any claim under § 102 (a) or § 102 (e). Applicants request clarification as to the inclusion of these quotations.

E. 35 U.S.C. § 103 (a)

The Office Action states the basis for all obviousness rejections set forth in the instant Office Action. Office Action, ¶ 9. The Office Action, however, does not reject any of the claims under § 103. Applicants request clarification as to the inclusion of this paragraph.


CONCLUSION

In accordance with the foregoing, it is respectfully submitted that all outstanding objections and rejections have been overcome and/or rendered moot. Further, all pending claims patentably distinguish over the prior art, taken in any proper combination. Thus, there being no further outstanding objections or rejections, the application is submitted as being in a condition for allowance, which action is earnestly solicited.

If the Examiner has any remaining informalities to be addressed, it is believed that prosecution can be expedited by Examiner contacting the undersigned attorney for a telephone interview to discuss resolution of such informalities.

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